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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,103	12/28/2001	Dhananjay V. Keskar	10559/582001/P11136	2363

7590 01/18/2005  
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EXAMINER

LE, BRIAN Q

ART UNIT PAPER NUMBER

2623

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/041,103

Applicant(s)

KESKAR ET AL.

Examiner

Brian Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/28/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5-7, 14-15, and 21-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 5, the original disclosure does not show the support for the limitation “recognized only if the command mark is placed in a specified area of the medium”. Referring to claim 6, the original disclosure does not show the support for the limitation “first command mark must be recognized before any other command marks are recognized as executable commands”. And also to claim 7, the original disclosure does not show the support for the limitation “the medium includes printed text, and wherein the recognized command mark is executed to affect the printed text”. For claims 14-15, please refer back to claims 5-6 for the explanation. Regarding claims 21-22, please refer back to claims 5 and 7 for the explanations.

***Claim Objections***

3. Claims 5-7, 14-15, and 21-22 are objected to because these claims are very difficult to understand due to the use of confusing language. Appropriate correction is required. The prior art rejection based on the Examiner’s best understanding.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5-12, 14-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson U.S. Patent No. 5,897,648.

Regarding claim 1, Henderson teaches a method comprising:

obtaining a scanned command mark written with a conventional writing implement onto a conventional medium (column 4, lines 26-41); and

recognizing the scanned command mark as a command that may be executed by a processor (by computer) (recognized the edit command and further provide the edited document) (column 2, lines 56-67 and FIG. 3).

Referring to claim 2, Henderson teaches the method wherein the command mark comprises one of a operational mark (editing mark includes annotations, changes, additions, and removing marks) (column 4, lines 26-33).

For claim 3, Henderson also teaches the method wherein recognizing comprises: recognizing a pattern associated with the command mark based on one of a statistical model (computation by generated equations) (column 8, lines 21-67).

Regarding claim 5, Henderson discloses the method wherein the command mark is recognized only if the command mark is placed in a specified area of the medium (only recognize based on specific location and orientation) (column 6, lines 35-44).

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For claim 6, Henderson also discloses the method wherein a first command mark must be recognized before any other command marks are recognized as executable commands (recognizing executable commands) (column 4, lines 1-10).

Referring to claim 7, Henderson shows the method wherein the medium includes printed text, and wherein the recognized command mark is executed to affect the printed text (printing text) (column 3, lines 50-55).

Regarding claim 8, Henderson teaches the method further comprising: executing the recognized command in the processor (column 4, lines 1-10).

For claim 9, Henderson also teaches the method further comprising: storing the recognized command in memory (column 7, lines 11-26).

Regarding claims 10-12, and 14-17, please refer back to claims 1-3 and 5-9 for the teachings and the explanations.

Regarding claim 18, please refer back to claim 1 for the teaching and explanation. In addition, Hender teaches a machine-readable medium that stores machine-executable instructions for perform the claimed limitations (the computer and software) (FIG. 3 and column 12, lines 20-34).

Regarding claims 19-24, please refer back to claims 2-3, 5, and 7-9 for further teachings and explanations.

For claims 25-28, please refer back to claims 1-2, 18 and 9 for the teachings and explanations.

Regarding claim 29, please refer back to claim 1 and 18 for the teachings and explanations. In addition, Henderson teaches the obtain stroke data that corresponds to the

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written command mark (digitizing and scanning process) (column 2, lines 43-55), and recognize the stroke data as an executable command (recognized the edit command and further provide the edited document) (column 2, lines 56-67).

For claim 30, Henderson further teaches the apparatus further comprising: a digital ink detecting device which detects the command mark as stroke data (digitizer pen) (column 4, line 3-5).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson U.S. Patent No. 5,897,648 as applied to claim 2 above, and further in view of Berman U.S. Patent No. 5,768,418.

Regarding claim 4, Henderson teaches the pattern recognition (recognized the edit command) (column 2, lines 56-67). Henderson does not explicitly teach the application of heuristic techniques to enhance accuracy of the pattern recognition. Berman further teaches a handwriting command processing utilizing the heuristic techniques (column 3, lines 30-36 and column 5, lines 40-45). Modifying Henderson's method of processing written command mark according to Berman would be able to utilize heuristic technique in pattern recognition to enhance the accuracy. This would improve processing and therefore, it would have been obvious to one of ordinary skill in the art to modify Henderson according to Berman.

Regarding claim 13, please refer back to claim 4 for the teaching and explanation.

### *CONCLUSION*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to written command mark processing on a conventional medium:

U.S. Pat. No. 6,466,954 to Kurosawa, teaches method of analyzing a layout structure of an image using character recognition, and displaying or modifying the layout.

U.S. Pat. No. 5,363,211 to Hasebe, teaches image processing apparatus having means for magnifying a portion of a document selected through color marking.

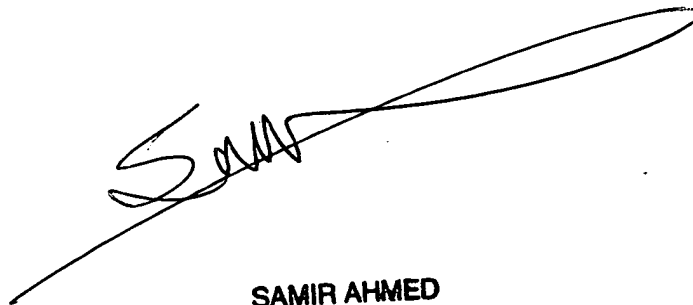
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 703-305-5083. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC Customer Service whose telephone number is 703-306-0377.

BL  
January 11, 2005

A handwritten signature in black ink, appearing to read 'Samir', with a long, sweeping horizontal line extending to the right.

**SAMIR AHMED  
PRIMARY EXAMINER**